

REMARKS / ARGUMENTS

The present application includes pending claims 1-20, all of which have been rejected. By this Amendment, claims 1-6 and 16-20 have been cancelled, claims 7-9 and 12 have been amended, and new claims 21-50 have been added. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth “all reasons and bases” for rejecting the claims.

Claims 1-20 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 7-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,452,235, issued to Isani (hereinafter, Isani), in view of U.S. Patent No. 5,812,144, issued to Potu et al. (hereinafter, Potu). The Applicant respectfully traverses these rejections at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 101

The Applicant first turns to the rejection of claims 1-20 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. The Office Action states:

Regarding claims 1 and 16, the claimed steps of the method do not recite any post-computer process activity, i.e., no independent physical acts and no manipulation of data representing physical objects or activities. Regarding claim 20, the claim recites a video scaler comprising input, a scaler engine and a memory.

Therefore, in order to determine if the process is statutory, one must determine what the computer does to achieve a practical application. A process that merely manipulates an abstract idea is non-statutory despite the fact that it might inherently have some usefulness. For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea. **Examiner finds no limitation to a practical application for the claimed method.** The preamble of the claim is given little weight in establishing a statutory claim when there are no elements in the claim limitations into which the preamble could give substantial meaning of a practical limitation. Examiner suggests outputting to a display or providing a tangible output device to provide useful, concrete and tangible result.

See Office Action at pages 2-3. It appears that the Examiner is only challenging whether Applicant's claims 1 and 16 have practical application, i.e., whether Applicant's claims 1 and 16 produce useful, tangible and concrete result.

The Applicant points out that originally filed claims 1-6 and 16-20 have been cancelled. New claims 21-29 and 30-39 correspond to the cancelled claims 1-6 and 16-20, respectively.

The Applicant respectfully asserts that the disclosed and claimed invention produces useful, tangible and concrete results. The Applicant's invention provides utility that is (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107 and Fisher, 421 F.3d, 76 USPQ2d at 1230. **For example, each of claims 21-29 and 30-39 provides a practical application that produces a useful result, i.e., a method for processing video data.** Furthermore, the Applicant's disclosed and claimed invention clearly does not fall in the category of the § 101 Judicial exceptions. Accordingly, there is no need for the Applicant to distinguish the disclosed and/or claimed subject matter from the three § 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application.

With regard to tangible results, the Applicant respectfully asserts that the disclosed and claimed invention recites more than a § 101 judicial exception and

that the claims specifically set forth a practical application to produce a real-world result.

With regard to concrete results, since appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, in instances where the invention cannot operate as intended without undue experimentation. Since no such rejection was received, the Applicant assumes that the invention provides useful results. Notwithstanding, the Applicant respectfully asserts that the disclosed and claimed invention provides useful results and the results are repeatable and predictable.

The Applicant points out that the preambles of independent claims 21 and 30 specifically recite the utility of Applicant's claims, i.e., a method for processing video data. At least for the above reasons, the Applicant believes that new claims 21-39 comprise patentable subject matter and are believed to be allowable. The Examiner has stated that the originally-filed method claims 1 and 16 have "no practical application". The Applicant respectfully disagrees. For example, claim 21, which corresponds to claim 1, recites that a video image received by a video scaling engine may be scaled based on a determination of the video scaling engine's memory requirements. The Applicant submits that this is a useful, concrete and tangible result.

Accordingly, the Applicant courteously requests that the rejection under 35 USC § 101 be withdrawn and each of Claims 7-15 and 21-39 be allowed. The Applicant reserves the right to argue additional reasons beyond those set forth above that support the allowability of all rejected claims.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art

cannot be relied upon to provide the suggestion...,” citing *AI-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Isani and Potu Does Not Render Claims 7-15 Unpatentable

The Applicant now turns to the rejection of claims 7-15 as being unpatentable over Isani in view of Potu. The Applicant notes that the proposed combination of Isani and Potu forms the basis for all of the pending rejections.

A. Independent Claim 7

With regard to the rejection of independent claim 7 under 103(a), the Applicant submits that the combination of Isani and Potu does not disclose or suggest at least the limitation of “a scaler engine capable of both downscaling the video image to generate a first scaled video image and upscaling the video image to generate a second scaled video image, the scaler engine using a clock selected between a video input clock and a display output clock,” as recited by the Applicant in independent claim 7.

The Office Action concedes the following:

However it is noted that Isani fails to disclose capable of both downscaling the video image to generate a first scaled video image and upscaling the video image to generate a second scaled video image, the scaler engine using a clock selected between a video input clock and a display output clock; and means for determining whether the video image is to be downscaled or upscaled.

See the Office Action at page 4. To address the deficiencies of Isani, the Examiner seeks support in Potu, and states the following:

Potu discloses capable of both downscaling the video image to generate a first scaled video image and upscaling the video image to generate a second scaled video image (col. 5, lines 43-56), using a clock selected between a video input clock and a display output clock (col. 5, lines 50-52); and means for determining whether the video image is to be downscaled or upscaled (col. 5, lines 5-7).

See *id.* at page 4. Initially, the Applicant points out that the video adapter 22 of Potu performs on-the-fly resizing **without requiring separate scaling chip**. See Potu, col. 5, lines 49-53. In other words, Potu does not disclose or suggest a scaler engine as recited in Applicant's claim 7.

With regard to Applicant's limitation of "using a clock selected between a video input clock and a display output clock," the Examiner seeks support in the following citation:

What video adapter 22 provides is the ability to perform on-the-fly resizing with pixel clock manipulation 50 of time-interleaved digital video component YVV data without requiring a separate scaling chip, additional buffers, or associated interface logic.

See Potu, col. 5, lines 50-52. The Applicant is confused as to why the Examiner is using this citation since col. 5, lines 50-52, as well as the remaining portion of Potu, does not disclose or suggest "using a clock selected between a video input clock and a display output clock," as recited in Applicant's claim 7. In fact, Potu does not disclose of any clock signal selection by the video adapter 22.

With regard to Applicant's limitation of "means for determining whether the video image is to be downscaled or upscaled," the Examiner seeks support in the following citation:

Synchronization signals from video decoder 40 are also forwarded to field memory 46 through either field memory write and downscale logic 46A or field memory read and upscale logic 46B.

See Potu, col. 5, lines 5-7. The Applicant is confused as to why the Examiner is using this citation since col. 5, lines 5-7, as well as the remaining portion of Potu, does not disclose or suggest "means for determining whether the video image is to be downscaled or upscaled," as recited in Applicant's claim 7. In fact, Potu does not disclose of any determination of whether an image is to be upsampled or downscaled by the video adapter 22.

As shown above, neither Isani nor Potu teach or suggest "a scaler engine capable of both downsampling the video image to generate a first scaled video image and upscaling the video image to generate a second scaled video image,

the scaler engine using a clock selected between a video input clock and a display output clock," as recited by the Applicant in independent claim 7.

Accordingly, the proposed combination of Isani and Potu does not render independent claim 7 unpatentable, and a *prima facie* case of obviousness has not been established.

B. Rejection of Dependent Claims 8-15

Based on at least the foregoing, the Applicant believes the rejection of independent claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Isani in view of Potu has been overcome and requests that the rejection be withdrawn. Additionally, claims 8-15 depend from independent claim 7, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 8-15.

II. New Claims 21-50

The Applicant points out that originally filed claims 1-6 and 16-20 have been cancelled. New claims 21-29 and 30-39 correspond to the cancelled claims 1-6 and 16-20, respectively. In addition, new claims 40-50 correspond to claims 7-15.

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Therefore, the Applicant submits that no new matter has been added by claims 21-50, and claims 21-50 are allowable.

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CONCLUSION

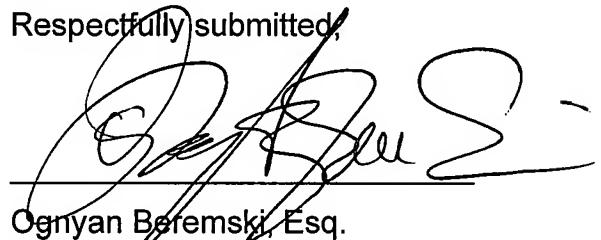
Based on at least the foregoing, the Applicant believes that all claims 7-15 and 21-50 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Date: 28-JUN-2007

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ognyan Beremski', is written over a horizontal line.

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